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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/234,028	01/20/99	RAINES	R 960296.95360

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HM12/0928

EXAMINER

HUTSON, R

ART UNIT	PAPER NUMBER
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1652

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DATE MAILED: 09/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/234,028

Applicant(s)

Ronald T. Raines

Examiner

Richard Hutson

Group Art Unit

1652



☒ Responsive to communication(s) filed on Jan 20, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-14 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

DETAILED ACTION

1. The art unit location of your application and examiner has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit **1652**, Examiner **Richard Hutson Ph.D.**

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a mutant ribonuclease inhibitor, classified in class 530, subclass 350.
- II. Claims 11-14, drawn to a DNA sequence encoding a mutant ribonuclease inhibitor, classified in class 536, subclass 23.5.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the mutant ribonuclease inhibitor of Group I, and the nucleic acid encoding a mutant ribonuclease inhibitor of Group II each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The peptide of Group I is comprised of amino acid sequence and the DNA of Group II is comprised of nucleic acid sequence. The DNA has other utility besides encoding protein such as a hybridization probe, and the proteins can be made synthetically. Additionally, the

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protein can be used to perform specific biological function(s) which are independent of the function(s) of the DNA molecule. The protein has other utility such as for the inhibition of ribonuclease.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. *"For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02."* (see MPEP 803). The serious burden of search has been established by the different classification of the inventions.

4. A telephone call was made to Nicholas Seay on 9/15/2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on M-F from 7:30 to 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapy Achutamurthy (Murthy), can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Richard Hutson Ph.D.
9/25/2000

Rebecca P. Perty
REBECCA E. PERTY
PATENT EXAMINER
GROUP 1000
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